



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Parsons et al. :
Serial No.: 10/624,883 : Group Art Unit: 2155
Filed: July 21, 2003 : Examiner: Barot, Bharat
Title: **SYSTEMS AND METHODS FOR DOMAIN NAME
REGISTRATION BY PROXY**

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Sir:

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1. Copy of Notice of Allowance and Fee(s) Due (1 page);
2. Part B Issue Fee Transmittal form (1 page in duplicate);
3. Comments on Statement of Reasons for Allowance (5 pages);
4. Check for \$1,700.00; and
5. A return receipt postcard.

Dated: 9/18/2006

By: Suzanne Shields

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COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

On July 13, 2006 a Notice of Allowance and Fee(s) Due, Determination of Patent Term Adjustment under 35 U.S.C. 154(b), Notice of Allowability, Examiner's Amendment and Reasons for Allowance were issued in the above-identified application. The Reasons for Allowance stated are as follows:

The examiner has found that the prior art of record does not disclose or teach or suggest or render obvious a specific combination of a system, method, and computer program for a proxy entity domain name registration comprising: "proxy installation" for receiving and storing personal contact information communicated to the proxy installation by the registrar installation and communicating proxy personal contact information to the registrar: and "registrar installation" responsive the communication of personal contact information by the proxy installation to: submit a registration request and the proxy personal contact information from the proxy installation to a registry at set forth in the specification and recited in the independent claims.

In the second to last line of the above-quoted comments the word "at" is understood to be a typographical error and it is understood that word should be "as."

The statement that the "prior art of record does not disclose or teach or suggest or render obvious a specific combination of a system, method, and computer program for a proxy entity domain name registration ..." is incorrect and is disagreed with if it is intended to express that any of the allowed claims refers to the combination of a system, method, and computer program.

It is believed that the word "combination" was intended to refer to the terms after the word "comprising" and the colon in line three of the paragraph.

As for the terms following the word "comprising" and the colon in line three of the quoted paragraph, these can be reasons for allowance only with respect to allowed independent claim 1 and allowed dependent claims 2 - 6, 71, 78 and 79. That is because these are the only claims among the allowed claims that contain the terms set forth in the Reasons for Allowance. In other words, claim 1 does call for "' proxy installation' for receiving and storing personal contact information communicated to the proxy installation by the registrar installation and communicating proxy personal contact information to the registrar: and 'registrar installation' responsive [to] the communication of personal contact information by the proxy installation to: submit a registration request and the proxy personal contact information from the proxy installation to a registry," as stated in the Reasons for Allowance. Applicants agree that the prior art of record does not teach or suggest the quoted provisions of claim 1. Claims 2 to 6, 71, 78 and 79 include the terms of claim 1 by their dependencies, and so the above-quoted claim terms from the examiner's Reasons for Allowance patentably distinguish these claims from the prior art of record, too.

Also, the inclusion of the above-quoted terms from claim 1 is not necessarily the exclusive basis for the patentability of claims 1 - 6, 71, 78 and 79. It is noted that the examiner's Reasons for Allowance does not say that the above-quoted terms are the exclusive basis for the examiner's finding that the allowed claims are patentable.

As for the remaining allowed claims, the reasons that these claims are patentable over the prior art of record are those that are set forth in applicants February 22, 2006 Response to Official Action.

Independent claim 7 and the claims dependent therefrom, claims 8 - 16, 72, 80 and 81, do not include the above-quoted terms referred to in the examiner's Reasons for Allowance. Independent claim 7 and claims dependent from it relate to the proxy, not the registrar. Consequently it does not have, by any interpretation, a "registrar installation." Nor does claim 7 or its dependent claims have anything "responsive [to] the communication of personal contact information by the proxy installation or that submits a registration request or proxy personal contact information ... to a registry." Further, the proxy provisions of claims 7, 8 - 16, 72, 80 and 81 are not identical to the "proxy installation" provisions set forth in the Reasons for Allowance.

Thus, the reasons that these claims are patentable cannot be the reasons stated in the Reasons for Allowance. Rather, the bases for the patentability of these claims are, inter alia, those set forth in the applicants' February 22, 2006 Response to Official Action.

Independent claim 12 and claims dependent from it, claims 13 - 18, 73, 82, 92 and 93, are method claims directed to operations that ordinarily would be the activities of a registrar operating in the manner of applicants' invention. These claims do not include any of the above-quoted provisions set forth in the Reasons for Allowance. Moreover, these claims do not relate to proxy activities they cannot be said to be related to the "proxy installation" or that installation's functions as set forth in the Reasons for Allowance. Again, the reasons for the patentability of claims 12, 13 - 18, 73, 82, 92 and 93 are, inter alia, those set forth in applicants' February 22, 2006 R3esponse to Official Action and cannot be the reasons expressed in the Reasons for Allowance.

The computer program claimed in independent claim 26 and the dependent claims 27 - 34, 75, 86 and 87 relates to the programming for the what would typically be registrar operations not proxy operations. Here too, because the claims related to programming, they do not claim either the "proxy installation" or the "registrar installation" that the examiner refers to in the Reasons for Allowance. Because these claims do not relate to programming of proxy operations the above-quoted terms that relate to proxy installation "receiving and storing personal contact information" and "communicating proxy personal contact information to the registrar" are not present, nor is programming to accomplish those activities. The Reasons for Allowance stated cannot, therefore, apply to these program claims. The reasons why these claims 26 - 34, 75, 86 and 87 are patentable over the prior art of record are those expressed in applicants' February 22, 2006 Response to Official Action.

Independent claim 44 and claims dependent from it, claims 45 - 47, are computer program claims that relate to what typically would be the proxy operations. Because these are claims directed to the programs they do not claim either the "proxy installation" or the "registrar installation" discussed in the Reasons for Allowance as affording patentability. In addition because the programming claimed is that of proxy operations, claims 44 - 47 do not relate to the operations of a registrar or the programming for those operations, i.e. the registrar installation's submission of a "registration request and proxy personal contact information ... to a registry" in response to "communication of personal contact information" as set forth in the Reasons for

Allowance. The February 22, 2006 Response to Official Action sets forth reasons for patentability of these claims over the prior art of record. These are once again, inter alia, the bases of why these claims are allowable.

Independent claim 69 and claim 70 dependent from claim 69 relate to a domain name registration system that claims the features that ordinarily would be those of the registrar not the proxy. These claims do not have the "proxy installation," do not claim "receiving and storing personal contact information communicated to the proxy installation by the registrar installation," and do not claim "communicating proxy personal contact information to the registrar." Consequently, these claim provisions, recited in the Reasons for Allowance, cannot apply to claims 69 and 70. The reasons these claims are patentable are, inter alia, those discussed in the February 22, 2006 Response to Official Action.

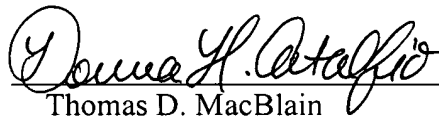
While the above comparison to the stated reasons for allowance of the allowed claims refers to one or more claim terms referred to in the stated reasons that are clearly not present in those allowed claims and that make it evident that the stated reasons do not apply to a particular allowed, it should be recognized that the foregoing comparison is not exhaustive. Many of the allowed claims do not include terms referred to in the reasons for allowance, in addition to those expressly pointed to above.

In view of all of the above, the stated reasons for allowance included with the Examiner's Amendment and Notice of Allowance in this application should not be understood to bear on the interpretation of the allowed claims other than claim 1 and claims 2 - 6, 71, 78 and 79 dependent from claim 1.

Respectfully submitted,

GALLAGHER & KENNEDY, P.A.

Date: September 18, 2006

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